

REMARKS

This is a full and timely response to the final Office Action mailed on April 20, 2005. Reconsideration and allowance of the application and presently pending claims are respectfully requested in view of the foregoing remarks.

I. Election/Restriction

Applicants affirm the election of Group III, particularly claims 57-59, 61, 63-65, 92-98, and 101-103. Claims 66-71, 73-79, 81, 83-91, 99, and 100 are cancelled without prejudice, waiver, or disclaimer. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these cancelled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the cancelled subject matter to the public.

II. Priority

In the Office Action, it was alleged that the limitation wherein sequential data supplements are provided responsive to user in a manner that is synchronized with the video presentation cannot be found in the provisional application (60/214,987) and co-pending application 09/590,520. Thus, the claims of the instant application stand to be examined in view of the following data of the instant application October 20, 2000.

Applicants are not addressing the validity of all assertions made in the Final Office Action regarding the priority of this application. Therefore, Applicants should not be presumed to agree with any statements made in the final Office Action regarding the priority of the application unless otherwise specifically indicated by Applicants.

III. Response to Claim Rejection under 35 U.S.C. §103

In the Office Action, claims 57-59, 61, 63-65, 92-98, and 101-103 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,628,302 to *White et al.* (hereinafter “*White*”) in view of U.S. Patent No. 6,324,694 to *Watts et al* (hereinafter “*Watts*”).

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious, the references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicants respectfully traverse the rejection.

Applicants respectfully submit that *White* in view of *Watts* does not teach or disclose all of the claimed features.

A. Claim 101

Claim 101 recites:

101. A method implemented by a television set-top-terminal (“STT”) configured to receive a video program from a remote server, comprising the steps of:

storing a first plurality of streams corresponding to the video program in the remote server, said first plurality of streams including a second plurality of streams and a supplementary data stream that is different than all the streams in the second plurality of streams, said second plurality of streams including an audio stream, a video stream, and a subtitle stream, said supplementary data stream corresponding to supplementary information;

providing a first selectable option to receive the video program from a plurality of video programs;

receiving a first viewer input from a viewer, the first viewer input being configured to select the first selectable option;

responsive to receiving the first viewer input, providing a second selectable option to receive the supplementary data stream in the STT;

receiving a second viewer input from a viewer responsive to providing the second selectable option,

responsive to receiving the second viewer input corresponding to selecting the second selectable option:

configuring transmission of the first plurality of streams from the remote server to the STT via a first transmission channel;

receiving a respective sequential portion of each stream in the first plurality of streams substantially

simultaneously via a tuner in the STT tuned to the first transmission channel;

storing the sequential portions of the supplementary data stream and each stream in the second plurality of streams into respective sections of a memory in the STT;
and

presenting the supplementary data stream and an audio stream and a video stream in the second plurality of streams in their respective decoded form simultaneously at a plurality of respective time intervals corresponding to respective portions of the video program; and responsive to receiving the second viewer input corresponding to a viewer input that is different than a viewer input corresponding to selecting the second selectable option:

- configuring transmission of the first plurality of streams from the remote server to the STT via a first transmission channel;
- receiving a respective sequential portion of each stream in the first plurality of streams substantially simultaneously via a tuner in the STT tuned to the first transmission channel;
- rejecting the supplementary data stream at the STT;
- storing the sequential portions of each stream in the second plurality of streams into respective sections of the memory in the STT; and
- presenting an audio stream and a video stream in the second plurality of streams in their respective decoded form simultaneously at a plurality of respective time intervals corresponding to respective portions of the video program.

(Emphasis Added)

- i. White in view of Watts fails to teach “responsive to receiving the first viewer input, providing a second selectable option to receive the supplementary data stream in the STT”

The Office Action admits that *White* “does not particularly disclose the details corresponding to the delivery of the requested video program in connection with the synchronous delivery, storage, and rendering of supplemental content as claimed.” (Office Action, page 6). In this regard, the Office Action refers to *Watts* to remedy the shortcomings of *White*. However, *Watts* does not disclose or suggest “responsive to receiving the first viewer input, providing a second selectable option to receive the supplementary data stream in the STT”, as recited in claim 101.

In fact, *Watts* apparently discloses that “an additional user-selectable icon is provided to the user which allows the user to toggle enablement of subsidiary data.” However, this “user-selectable icon” is apparently always provided in the programming guide and thus, is not “responsive to receiving the first user input.” In *Watts*, a user apparently selects the on-screen

programming guide in order to get to the user-selectable icon. Additionally, *Watts* does not disclose that the on-screen programming guide or the user-selectable icon is “responsive” to the “first viewer input” of selecting the video program. On the other hand, claim 101 recites the steps of “providing the first selectable option to receive a video program from a plurality of programs,” “receiving a first viewer input, the first user input being configured to select the first selectable option,” and “responsive to receiving the first viewer input, providing a second selectable option to receive the supplementary data stream in the STT.” (Emphasis added).

Consequently, Applicants respectfully submit that *Watts* fails to teach or disclose the step of “responsive to receiving the first viewer input, providing a second selectable option to receive the supplementary data stream in the STT”, as recited in claim 101. Accordingly, because *Watts* does not remedy the failure of *White* as previously discussed, Applicants respectfully submit that a *prima facie* case of obviousness using *White* in view of *Watts* cannot be established. Consequently, Applicants respectfully request that claim 101 be allowed and the rejection be withdrawn.

ii. No Reason to Combine the References

Applicants respectfully submit that “[t]he PTO has the burden under Section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” *ACS Hospital Systems, Inc., v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). “There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ 2d 1443 (Fed. Cir. 1992).

In the Office Action, it was admitted that *White* does not illustrate the “details corresponding to the delivery of the requested video program in connection with the synchronous delivery, storage and rendering of supplemental content as claimed” (Office Action, page 6). In

this regard, the Office Action refers to *Watts* alleging that it teaches and suggests implementing a synchronous supplementary data stream to a video program. The Office Action cited the *White* VOD and alleged that it would have been obvious for one skilled in the art to combine the *White* VOD and the *Watts* synchronous supplementary data stream. Applicants respectfully disagree.

White apparently relates to a WebTV terminal utilizing VOD and the Internet to provide more information to users. *Watts* apparently discloses that the subsidiary data is received independent of primary data so that subsidiary data does not have to be received during vertical blanking intervals (VBI). There is no teaching, disclosure, or suggestion by *White* to combine *Watts* to produce the combination thereof. Indeed, nowhere in *White* does *White* discuss subsidiary data and nowhere in *Watts* does *Watts* disclose VOD. *White* provides no reason, suggestion, or motivation to combine VOD with subsidiary data. Applicants respectfully submit that a VOD implementation and subsidiary implementation are two different functionalities for a user and in no way do they inherently suggest to be combined with each other. Furthermore, many questions are raised as to how these inventions would be combined and still function as the inventors originally intended. Consequently, the combination of *White* in view of *Watts* fails to disclose, teach, or suggest enabling a VOD system to implement synchronous data streams, as recited in claim 101. Thus, a prima facie case of obviousness cannot be established based on *White* in view of *Watts*. For at least this reason, among others, Applicants respectfully request that independent claim 101 be allowed and the rejection be withdrawn.

B. Claims 57-59, 61, 63-65, 92-98 and 102-103

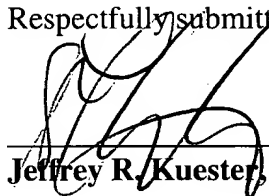
Because independent claim 101 is allowable over the cited references, dependent claims 57-59, 61, 63-65, 92-98 and 102-103 are also allowable as a matter of law for at least the reason that dependent claims 57-59, 61, 63-65, 92-98 and 102-103 contain all features and elements of their respective independent base claim. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicants respectfully request that the rejection to dependent claims 57-59, 61, 63-65, 92-98 and 102-103 be withdrawn for this reason.

CONCLUSION

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well-known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

Applicants respectfully maintain that the currently pending claims are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester, Reg. No. 34,367

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500